

Doc. Code: AP.PRE.REQ

PTO/SB/33 (07/05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

22.1489 (SHL.0293US)

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Signature

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name

Janice Munoz

Application Number

10/043,856

Filed

01/11/2002

First Named Inventor

Jean-Luc Pous

Art Unit

3625

Examiner

Nicholas D. Rosen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 40,779

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Fred G. Pruner, Jr.

Typed or printed name

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Telephone number

April 2, 2007

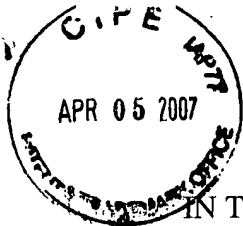
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicants:	Jean-Luc Pous et al.	§	Art Unit:	3625
		§		
Serial No.:	10/043,856	§		
		§	Examiner:	Nicholas D. Rosen
Filed:	January 11, 2002	§		
		§		
Title:	Custom Engineered	§	Docket No.	22.1489
	Product System And	§		(SHL.0293US)
	Process	§		

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant seeks pre-appeal review of the § 103 rejections of claims 38 and 42-62.

Regarding the § 103 rejections, the Examiner concedes that neither EMCORE nor House discloses via an unavailable product/attribute selector, using selections of unavailable products as market research. Office Action, 3 and 13. Thus, a *prima facie* case of obviousness has not been established for any of the claims for at least the reason that the hypothetical combination of House and EMCORE fails to teach or suggest all claim limitations. More specifically, the Examiner appears to rely on House for the general teaching of a product selector and rely on EMCORE for the teaching of expanding a product line based on market research. However, neither reference, alone or in combination, teaches or suggests expanding a product line based on selection of an unavailable product by a product/attribute selector. Without the disclosure of the missing elements, a *prima facie* case of obviousness has not been established for any of the claims.

Date of Deposit: April 2, 2007

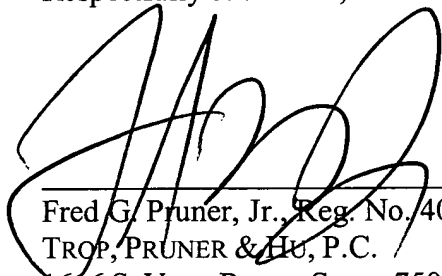
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Janice Munoz

The Examiner refers to *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988) for the purported authority for relying on the general level of skill in the art to establish a *prima facie* case of obviousness. However, in *In re Fine*, the Federal Circuit held that the Examiner had *failed* to establish a *prima facie* case of obviousness for the reason that the Examiner failed to show where the prior art taught or suggested all claim limitations. Rarely, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment. *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999). Thus, the Examiner must show that one skilled in the art, *without knowledge of the claimed invention*, would have derived the claimed invention in view of the EMCORE reference and House. Objective evidence is required, as mere speculation by the Examiner is not sufficient to establish a *prima facie* case of obviousness. *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Therefore, for at least the following reasons, withdrawal of the § 103 rejections of claims 42-55 is respectfully requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0293US).

Respectfully submitted,



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Date: April 2, 2007